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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/077,727

02/15/2002

David F. Gavin

101792-200

2648

27267

7590

11/27/2006

WIGGIN AND DANA LLP  
ATTENTION: PATENT DOCKETING  
ONE CENTURY TOWER, P.O. BOX 1832  
NEW HAVEN, CT 06508-1832

EXAMINER

SHIBUYA, MARK LANCE

ART UNIT

PAPER NUMBER

1639

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No. 10/077,727	Applicant(s) GAVIN ET AL.	
	Examiner Mark L. Shibuya, Ph.D.,	Art Unit 1639	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 08 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on 08 September 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

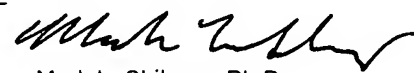
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): None.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: None.  
Claim(s) objected to: None.  
Claim(s) rejected: 2,4,6-11,35,36, and 40.  
Claim(s) withdrawn from consideration: None.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: Please see attached.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_

  
Mark L. Shibuya, Ph.D.,  
Primary Examiner  
Art Unit: 1639

***Advisory Action, Response to Arguments***

1. Applicant traverses the rejection of claims 2, 4, 6-10 and 40 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hosseini et al., US Pat. No. 5,540,860 (7/96) alone or if necessary further in view of the specification {e.g. page 7, figures (e.g. fig. 2) and examples (e.g. example 1) to demonstrate inherency.

Applicant argues that the reference of Hosseini et al. does not disclose how to make or produce a biocidal composition comprising composite particles having a shell and a core. Applicant argues that Hosseini et al., at col. 2, lines 30-40, teach away from the claimed invention by alleging that Hosseini et al. describes reducing or eliminating the bonding of copper pyrithione molecules to one another.

Applicant's arguments filed 9/8/2006 have been fully considered but they are not persuasive.

The examiner respectfully submits that the prior art reference of Hosseini et al. discloses biocidal compositions comprising composite particles. The Hosseini et al. reference discloses a composition in particle form, which comprises the same components (copper and pyrithione) which possesses the same presently claimed utility (i.e., biocidal). Thus, the particle complex of Hosseini et al., which possesses ingredients within the scope of the presently claimed invention, would inherently possess the same physical parameters (i.e., core and shell).

According to MPEP 2112.01, where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Therefore, because Hosseini et al., teach the identical or substantially identical chemic structure, the properties applicant discloses and/or claims are necessarily present.

Applicant's argument that the prior art references of Hosseini et al. and Gavin et al. teach away from the claimed invention is not deemed persuasive because Hosseini et al., at col. 2, lines 6-16, teach particles, as in the instant claims. Therefore, the examiner respectfully submits that it is not clear that the reduction of elimination of agglomeration of copper pyrithione molecules prevents the production of particles or that Hosseini et al. teaches away from such particles, as Hosseini et al. plainly teach them.

Applicant's arguments do not explain how prevention of agglomeration of copper pyrithione or the avoidance of particle agglomeration, prevents the production of particles or compositions thereof, but merely assert that Hosseini et al. therefore teaches away from the claimed invention. Applicant is respectfully reminded that the

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arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir 1997) ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a *prima facie* case of obviousness."). MPEP 2145.

2. Applicant traverses the rejection of claims 2, 4, 6-11 and 40 under 35 U.S.C. 103(a) over Hosseini et al. and Gavin et al. US Pat. 5,342,437 (8/94).

Applicant argues that the reference of Hosseini et al. does not disclose how to make or produce a biocidal composition comprising composite particles having a shell and a core. Applicant argues that Hosseini et al., at col. 2, lines 30-40, teach away from the claimed invention by alleging that Hosseini et al. describes reducing or eliminating the bonding of copper pyrithione molecules to one another. Applicant argues that Gavin et al. does not suggest biocidal compositions of composite particles.

Applicant's arguments filed 9/8/2006 have been fully considered but they are not persuasive.

The examiner respectfully submits that the prior art reference of Hosseini et al. discloses biocidal compositions comprising composite particles. The Hosseini et al. reference discloses a composition in particle form, which comprises the same components (copper and pyrithione) which possesses the same presently claimed utility

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(i.e., biocidal). Thus, the particle complex of Hosseini et al., which possesses ingredients within the scope of the presently claimed invention, would inherently possess the same physical parameters (i.e., core and shell).

According to MPEP 2112.01, where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911, F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

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Applicant's arguments do not explain how prevention of agglomeration of copper pyrithione or the avoidance of particle agglomeration, prevents the production of particles or compositions thereof, but merely assert that Hosseini et al. therefore teaches away from the claimed invention. Applicant is respectfully reminded that the arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir 1997) ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a *prima facie* case of obviousness."). MPEP 2145.

3. Applicant traverses the rejection of claims 2, 4, 6-10, 35-37 and 40 under 35 U.S.C. 103(a) over Hosseini et al. '860 alone or in view of the specification (e.g. page 7, figures (e.g. fig. 2) and examples (e.g. example 1) to demonstrate inherency and Kappock et al. US Pat. 5,518,774 (5/96).

Applicant argues Kappock et al. teach complete transchelation of zinc with a soluble pyrithione salt to produce an insoluble pyrithione salt, contrary to the present invention.

Applicant's arguments filed 9/8/2006 have been fully considered but they are not persuasive.

The examiner respectfully submits that applicant's arguments are conclusory and not persuasive, in that there is no indication of how or in what manner the teachings of Kappock et al. are "contrary to the present invention", and how such a teaching would overcome the instant rejection. The instant specification does not appear to disclose incomplete transchelation.

Furthermore, it is respectfully noted that the claims do not recite limitations in regard to transchelation; therefore it is respectfully submitted that applicant argues limitations not found in the claims. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., transchelation that is not complete) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).